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PATENT APPLICATION
ATTORNEY DOCKET NO. 10002214-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sarah Brandenberger et al.

Application No.: 09/776,058

Confirmation No.: 9353

Filed: February 2, 2001

Art Unit: 2615

For: A SYSTEM AND METHOD FOR LENS
FILTER EMULATION IN DIGITAL
PHOTOGRAPHY

Examiner: G. V. Selby

PRE-APPEAL BRIEF

MS Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

In response to the Office Action dated March 20, 2006, finally rejecting claims 1-20, please amend the above-identified U.S. patent application as follows:

Remarks/Arguments begin on page 2 of this paper.

PRE-APPEAL BRIEF

Claims 1, 2, 4, 5, and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, US 6,683,649 (hereinafter Anderson), in view of Kim, US 6,137,532 (hereinafter Kim). Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Anderson. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Kim, and further in view of Shiomi, US 6,650,361 (hereinafter Shiomi).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious, see *In re Ratti*, MPEP 2143.01.

In Applicant's previous response asserts that there is no motivation to combine Anderson with Kim. In response, the Final Office Action of 3/20/2006 alleges that the color and burst signals of Kim are not incompatible with Anderson. Applicant respectfully disagrees. The color and burst signals are analog signals, whereas Anderson teaches a camcorder that uses coded digital signals. Thus in order to modify Anderson to be combined with Kim, Anderson must be modified to use analog signals. The Examiner further points out that Kim teaches both analog and digital data. However, Applicant notes that the values of digital data taught by Kim correspond to the amplitude of an analog color signal, wherein the phase difference between the analog color signal and a burst signal determines the hue. Anderson teaches using coded digital signals, and as such in order to combine Anderson with Kim, the principle of operation of Anderson must be changed to use a phase difference between the analog color signal and a burst signal to determine a hue instead of a coded digital signal. Therefore, Applicant asserts the teachings of the references do not render the claims *prima facie* obvious and requests that all rejections based on any combination of Anderson and Kim be withdrawn.

Further, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure (see *In re Vaeck*, MPEP 2143). The Examiner's stated motivation, on page 2 of the Final Office Action, of reducing the space needed to provide filtering options may be gleaned from the abstract, page 3 lines 3-12, and page 4 lines 11-16 of Applicant's specification. However, Applicant can find no aspect of Anderson or Kim providing such motivation. Thus, the stated motivation was found in Applicant's disclosure. Therefore, Applicant respectfully asserts that the teachings of the references do not render the claims *prima facie* obvious and requests that all rejections based on any combination of Anderson and Kim be withdrawn.

Additionally, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant asserts that the prior art references when combined do not teach nor suggest all the claim limitations.

Regarding claims 1, 3, and 6, claim 1 requires a processor configured to process said pixel data in response to said selected image filter to provide filtered image data. Anderson in view of Kim does not meet these limitations. The Final Office Action admits that Anderson does not teach these limitations and refers to Kim in order to meet these limitations. Applicant's previous arguments stated that Kim does not teach these limitations, in that the original color data C1 is discarded and new color data C2 is generated. In response, the Final Office Action at page 3 now refers to the color processor (117) as teaching these limitations instead of the color filter device. However, Applicant notes that Kim's color processor does not provide the functionality of Kim's color filter as both devices are connected in parallel, the outputs of which are switched so that one or the other may be used (see Figure 2). Thus, the output of Kim's color processor is not in response to the selected image filter and does not provide filtered image data. As such, Anderson in view of Kim does not teach nor suggest a processor configured to process said pixel data in response to said selected image filter to provide filtered image data. Therefore, Applicant respectfully asserts that claim 1 is patentable over the cited prior art and requests the rejection be withdrawn.

Claim 3 depends from independent claim 1, inheriting all the limitations of claim 1. As noted above, neither Anderson nor Kim teach all the limitations of claim 1, either alone or in combination. Thus, claim 3 sets forth features and limitations not found in Anderson in

view of Kim, as discussed above. Shiomi is not relied upon as teaching these limitations nor does it teach or suggest such limitations. Therefore, Applicant respectfully asserts that claim 3 is patentable over Anderson in view of Kim in further view of Shiomi and requests the rejection be withdrawn.

Claim 6 depends from independent claim 1, inheriting all the limitations of claim 1. As noted above, neither Anderson nor Kim teach all the limitations of claim 1, either alone or in combination. Thus, claim 6 sets forth features and limitations not found in Anderson in view of Kim, as discussed above. Safai is not relied upon as teaching these limitations nor does it teach or suggest such limitations. Therefore, Applicant respectfully asserts that claim 6 is patentable over Anderson in view of Kim in further view of Safai and requests the rejection be withdrawn.

Regarding claim 8, it requires a processor configured to perform an adjustment of the properties of said digital visual recording device to include selected ones of said filter effects. Anderson in view of Kim does not disclose at least these limitations. The Office Action admits "Anderson does not disclose editing and displaying an image using digital color filtering." However, Applicant notes that claim 8 does not include "editing" and "displaying." In any event, the Final Office Action then reads teachings of Kim onto limitations of claim 1. However, as discussed above, Kim does not teach the limitations of claim 1. Further, Kim does not address the limitation of including selected ones of said filter effects when adjusting the properties of said digital visual recording device. Thus, Anderson in view of Kim does not disclose all the limitations of claim 8. Therefore, Applicant respectfully asserts that claim 8 is patentable over Anderson in view of Kim and requests the rejection be withdrawn.

Regarding claim 15, claim 15 requires selecting a first filter and selecting a second filter. The Final Office Action admits that Anderson does not teach these limitations. Applicant's previous arguments noted that Kim teaches selecting a desired color instead of a first and a second filter. In response, the Examiner identifies the color selection key (222) as allowing the user to select a desired color, but then identifies a first filter as a B-Y color filtering effect and a second filter as an R-Y color filtering effect. Applicant notes that both the B-Y color filtering effect and the R-Y color filtering effect are based on the selection of a desired color and as such are not selected. Thus, Kim in view of Anderson does not teach

selecting a first filter and selecting a second filter. Therefore, Applicant respectfully asserts that claim 15 is patentable over the cited prior art and requests the rejection be withdrawn.

Dependent claims 2, 4-5, 7, 9-14, and 16-20 each depend from one of independent claims 1, 8, and 15, thus inheriting all the limitations of their respective base claim. Each of claims 1, 8, and 15 set forth features and limitations not found in the cited prior art. Thus, claims 2, 4-5, 7, 9-14, and 16-20 each contain features and limitations not found in the cited prior art, as discussed above. Therefore, Applicant respectfully asserts that claims 2, 4-5, 7, 9-14, and 16-20 are patentable over Dalal in view of Powers and requests the rejection be removed.

Applicant further notes that any grouping of claims in this Pre-Appeal Brief does not limit the grouping of claims for any subsequent documents or responses related to the prosecution of the instant application. As such, any Appeal Brief may contain a different grouping of claims than that of any found within this document.

CONCLUSION

In view of the above, Applicant believes the final rejection of claims of the pending application should be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002214-1 from which the undersigned is authorized to draw.

Dated: May 19, 2006

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568259097US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 05/19/2006

Signature: 

(Phyllis Ewing)

Respectfully submitted,

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